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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,828	09/20/2005	Timothy J Person	63026A	1661
109 7590 06/24/2008 The Dow Chemical Company Intellectual Property Section P.O. Box 1967 Midland, MI 48641-1967				
EXAMINER				
GRAY, JILL M				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
06/24/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/549,828

**Applicant(s)**

PERSON ET AL.

**Examiner**

Jill Gray

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF 298)  
Paper No(s)/Mail Date \_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More specifically, claim 8 is indefinite because the language of "wherein a semiconductive cable layer prepared from the composition strippably adheres to a second cable layer" is drawn to the future intended use and functions of the composition but does not constitute a clear positive recitation of said composition being a cable layer, and said layer being adhered to a second layer and is not limiting. Accordingly, the reliance on the aforementioned language in claim 8 is indefinite and lacks a clear antecedent basis. Thus the metes and bounds for which patent protection is being sought are not clear.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-9, and 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by European Patent Publication EP 334,993 (Watanabe).

Watanabe discloses a semiconductive composition suitable as a layer on a power cable, and method of making, said composition comprising a mixture of a high-temperature polymer and a soft polymer and a conductive filler and required by present claims 1 and 14-16. Applicants should note that claim 15 is a product-by-process claim wherein patentability is based solely on the product and not the process of making. The high temperature polymer and soft polymer have different heat resistances, per claim 3 and the polymer is of the type contemplated by applicants in present claims 4-6. In addition, the conductive filler can be carbon black, per claim 7. Applicants should note that the language of "high-temperature polymer" and "soft polymer" is not specific and subject to determination based upon the relative properties of any two polymers when compared together. Accordingly, it is the examiner's position that the teachings of Watanabe meet this requirement. Regarding claim 2, it is the position of the examiner that the composition of Watanabe is the same as that contemplated by applicants thus, this property would be the same as well. See entire document and in particular, abstract and page 3, lines 1-40. In addition, Watanabe discloses that a curing agent and a compatibilizing polymer can be included as required by claims 9 and 13. See examples. As to the requirement that "a semiconductive cable layer prepared from the

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composition strippably adheres to a second cable layer” this language is drawn to the future intended use of the composition and adds no patentable weight to present claim 1. Hence, the requirement of claim 8 is not limiting because it relies upon the intended use of the composition.

Therefore the teachings of Watanabe anticipate the invention as claimed in present claims 1-9 and 13-16.

5. Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by European Patent Publication EP 858,081 A2 (Yoshida).

Yoshida discloses a semiconductive cable composition suitable as a layer on a power cable, and method of making, said composition comprising a mixture of a high-temperature polymer and a soft polymer and a conductive filler, further including a coupling agent and curing agent as required by claims 1, 9-12 and 14-18. Applicants should note that claim 15 is a product-by-process claim wherein patentability is based solely on the product and not the process of making. The high temperature polymer and soft polymer have different heat resistances, per claim 3 and the polymer is of the type contemplated by applicants in present claims 4-6. In addition, the conductive filler can be carbon black, per claim 7. Applicants should note that the language of “high-temperature polymer” and “soft polymer” is not specific and subject to determination based upon the relative properties of any two polymers when compared together. Accordingly, it is the examiner’s position that the teachings of Watanabe meet this requirement. Regarding claim 2, it is the position of the examiner that the composition of Watanabe is the same as that contemplated by applicants thus, this property would be

the same as well. As to the requirement that "a semiconductive cable layer prepared from the composition strippably adheres to a second cable layer" this language is drawn to the future intended use of the composition and adds no patentable weight to present claim 1. Hence, the requirement of claim 8 is not limiting because it relies upon the intended use of the composition. See entire document, and for example, abstract, page 3, lines 10-50, page 4, lines 5-11 and 45-58.

Therefore, the teachings of Watanabe anticipate the invention as claimed in present claims 1-18.

6. Claims 1-8, 13-16, and 19-21 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by PCT Publication WO 02/31051 (Easter).

Easter discloses a semiconductive cable composition suitable as a layer on a power cable, and method of making, said composition comprising a mixture of a high-temperature polymer and a soft polymer and a conductive filler, as required by present claims 1 and 14-16. Applicants should note that claim 15 is a product-by-process claim wherein patentability is based solely on the product and not the process of making. See entire document and for example, abstract, pages 3-4 and 8. The high temperature polymer and soft polymer have different heat resistances, per claim 3 and the polymer is of the type contemplated by applicants in present claims 4-6. In addition, the conductive filler can be carbon black, per claim 7. Applicants should note that the language of "high-temperature polymer" and "soft polymer" is not specific and subject to determination based upon the relative properties of any two polymers when compared together. Accordingly, it is the examiner's position that the teachings of Easter meet

this requirement. Regarding claim 2, it is the position of the examiner that the composition of Easter is the same as that contemplated by applicants thus, this property would be the same as well. As to the requirement that "a semiconductive cable layer prepared from the composition strippably adheres to a second cable layer" this language is drawn to the future intended use of the composition and adds no patentable weight to present claim 1. Hence, the requirement of claim 8 is not limiting because it relies upon the intended use of the composition. In addition, Easter discloses a process for preparing a cable layer comprising the general steps of extruding a semiconductive composition, extruding a polymeric dielectric insulation and crosslinking as required by claims 19-21. See page10 and claims 33-38.

Therefore, the teachings of Easter anticipate the invention as claimed in present claims 1-8, 13-16, and 19-21.

No claims are allowed. Applicants have not clearly identified that which they regard as their invention. The prior art clearly teaches strippable semiconductive compositions of the type set forth by applicants in the present claims.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-Th and alternate Fridays 8:00-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton I. Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jill Gray  
Primary Examiner  
Art Unit 1794

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